

Appn. No. 10/813,423

Attorney Docket No. 8627-452
Client Reference No. PA-5344-RFB/DIV**II. Remarks**

Claims 1-5 are rejected and pending. With the remarks provided herewith, the Applicants respectfully request reconsideration and a withdrawal of all the rejections to the claims.

Claim Rejections - 35 U.S.C. §102(b)

Responsive to the rejections of claims 1, 2, 4 and 5 under 35 U.S.C. §102(b) as being anticipated by European Patent No. 0,769,306 to Engelson (*Engelson*), *Engelson* does not teach each and every element of the claimed invention. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. For example, each of claims 1 and 5 recite the steps of applying a first coating over a mandrel having a proximal portion and a distal portion and removing the first coating from the distal portion of the mandrel. Contrarily, *Engelson* teaches the application of a first coating solely over the proximal region of a mandrel rather than over the mandrel having a proximal portion and a distal portion.

The Examiner's reasons for maintaining the rejections to claims 1, 2, 4, and 5 are improper (see page 3 of the Detailed Action). For example, on page 3 of the Detailed Action, the Examiner improperly states that some of the first coating would inherently be sprayed on the distal portion because *Engelson* does not take any extra effort such as masking the distal portion to coat solely over the proximal portion. The Examiner must provide rationale or evidence tending to show inherency. M.P.E.P. §2112. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *Id.* To establish inherency, the extrinsic evidence must



Appln. No. 10/813,423

Attorney Docket No. 8627-452
Client Reference No. PA-5344-RFB/DIV

make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 745; 49 U.S.P.Q 2d 1949, 1950-51 (Fed.Cir.1999). Here, the Examiner has not provided evidence or rationale that the first coating would be sprayed on the distal portion. Rather, the Examiner simply relies on *Engelson*'s lack of disclosure to solely coat the proximal portion of the guide wire. The mere possibility that coating the distal portion may occur based on an absence of a masking step is not sufficient.

Moreover, the Applicants respectfully disagree that it would be inherent to remove any undesired coating, including the first coating from the distal portion, as argued by the Examiner. The Examiner relies on the reasoning that the cleaning procedure taught by *Engelson* would inherently remove any undesired coating on the distal portion. Detailed Action, Page 3. However, the Applicants respectfully submit that "the mere fact that a certain thing may result from a given set of circumstances is not sufficient" and "[i]nherency may not be established by probabilities or possibilities." See *In re Robertson*, 169 F.3d 743, 745; 49 U.S.P.Q 2d 1949, 1950-51 (Fed.Cir.1999). Here, the mere possibility that a subsequent coating would remove any undesired coating is not sufficient. The Examiner has not made it clear how a cleaning procedure would inherently remove any undesired coating on the distal portion. Rather, the Examiner improperly states the argument as a conclusion.

Furthermore, the Applicants believe that the Examiner has misinterpreted the teaching in *Engelson*. The Examiner states that *Engelson* teaches "applying first coating on the majority of its length located proximally by spraying the coating over mandrel having a proximal portion and a distal portion." However, "[t]he guide wire



Appln. No. 10/813,423

Attorney Docket No. 8627-452
Client Reference No. PA-5344-RFB/DIV

(100) typically has a total length typically between about 50 and 300 centimeters" and "[t]he relatively more flexible distal section (106) extends for 3 to 45 centimeters or more of the distal end of the guide wire (100)." *Engelson*, column 5, lines 30-36. Although the Examiner may be correct that the first coating in *Engelson* is applied on the majority of the length of the mandrel, it is only because the majority of the length of the mandrel is its proximal section 102 while merely 3 to 45 centimeters encompasses the length of the more flexible distal section 106 of the guide wire 100. Col. 5, lines 30-36.

Moreover, although *Engelson* may or may not take any extra effort such as masking the distal portion in order to coat solely over the proximal portion thereof, *Engelson* still fails to teach applying a first coating over the distal portion of the mandrel. Any coating of the non-hydrophilic lubricious polymer on the distal portion would be by mere accident and is not taught in *Engelson*. Furthermore, whether or not the cleaning procedure would remove any undesired coating is non-responsive to the Applicants' argument that *Engelson* fails to teach each and every element of the invention as claimed in the present application.

Further, the Examiner's assertion that *Engelson* teaches the step of removing the first coating from the distal portion of the mandrel is misplaced. Since *Engelson* fails to disclose the application of a first coating to the distal portion of the mandrel, *Engelson* cannot possibly disclose the removal of such coating from the distal portion of the mandrel as recited in claims 1 and 5. The procedure to remove the first coating from the distal portion of the mandrel the Examiner refers to is merely a cleaning process to prepare the guidewire for the application of a hydrophilic polymer rather than a process for removing a first coating from the distal portion of the mandrel. (*Engelson*, col.10, lines 10-15). *Engelson* discloses that the guidewire



Appn. No. 10/813,423

Attorney Docket No. 8627-452
Client Reference No. PA-5344-RFB/DIV

core is "cleaned with an oxygen plasma etch," and a "plasma-polymerized tie layer" is deposited "on the guidewire core to complete the pretreatment." (Col. 10, lines 16-20). *Engelson* further discloses that "the pretreated guidewire may then be coated by a hydrophilic polymer." (Col. 10, lines 48-49). However, *Engelson* does not disclose the steps of applying a first coating to a mandrel and *removing* the first coating from the distal portion of the mandrel. Hence, *Engelson* fails to teach each and every element of the claimed invention.

Accordingly, reconsideration of the rejections under 35 U.S.C. §102(b) and the allowance of claims 1 and 5 are respectfully requested.

Further since claims 2 and 4 depend generally from claim 1, the reasons for allowance of claim 1 apply as well to the dependent claims.

Claim Rejections - 35 U.S.C. §103(a)

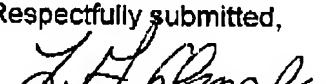
Claim 3 has been rejected under 35 U.S.C. §103(a) as being unpatentable over *Engelson* in view of U.S. Patent No. 6,652,472 to Jafari et al. (*Jafari*). Since claim 3 generally depends from claim 1, the reasons for allowance of claim 1 apply as well to claim 3. Accordingly, reconsideration and a withdrawal of the rejections under 35 U.S.C. §103(a) are respectfully requested.

Conclusion

Claims 1-5 are in a condition for allowance and such action is earnestly solicited.

Respectfully submitted,

May 21, 2007
Date


Lawrence G. Almeda (Reg. No. 46,151)

